

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1284-001

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/588,091

Filed

July 28, 2006

First Named Inventor

John M. Stencel

Art Unit

2856

Examiner

Helen C. Kwok

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☐ attorney or agent of record.

Registration number \_\_\_\_\_

☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 41,713


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8/18/09

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of	:	
	:	
JOHN M. STENCEL	:	Confirmation No.: 4355
	:	
Serial No.: 10/588,091	:	Group Art Unit: 2856
	:	
Filed: July 28, 2006	:	Examiner: Helen C. Kwok
	:	
For:	:	
	:	
INSTRUMENTS RELATED SYSTEMS, AND METHODS	:	
FOR MONITORING OR CONTROLLING FOAMING	:	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a Pre-Appeal Brief Request for Review of the final rejections made in the Office Action dated March 18, 2009, submitted concurrently with a Notice of Appeal and a petition for an extension of time of two (2) months. Upon carefully considering the following comments and arguments of record incorporated herein by reference, Applicant believes the panel will find that the present Examiner committed the following factual and legal errors in rejecting the claims.

In the Action, claims 1-4, 8-16 and 21-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,153,396 to Genser ("Genser"). This reference discloses a rotary evaporator including a rotating container 2 for receiving a medium (M) that contains at least one substance to be evaporated, a drive means 6 for rotating the container around an axis of rotation and a control mechanism 60 that controls the drive means via a control signal. The rotating speed of the container 2 is automatically controlled based upon the vibration behavior or the mass moment of inertia of the container. In more detail, two external "foam sensors" 14, 15, which are described as optic or infrared sensors, are used to detect a foam formation in the inside of the container 2 and an inclinometer 16 is used to detect the vibrations of the rotating container.

Independent claim 1 requires an instrument for monitoring or controlling a foam associated with a process or an object, including "a passive sensor for generating an output signal representative of an

acoustic emission associated with the foam” and “a controller in communication with the passive sensor for receiving the output signal and providing a response.” Independent claim 13 requires a method of monitoring and controlling a process involving a foam including the steps of “detecting an acoustic emission of the foam” and “actuating a response based on the detected acoustic emission.” Finally, independent claim 21 uses “means plus function” language to characterize the invention.

In the Action, the Examiner contends that Genser discloses all the claimed aspects of claims 1, 13 and 21. Specifically, the Examiner states that Genser discloses “a plurality of passive sensors 14, 15 (i.e. hydrophone) for generating an output signal representative of an acoustic emission associated with a foam M of an object (i.e. liquid F).” See *Office Action dated 3-18-2009*, p. 2. Importantly, the Examiner’s position that foam sensors 14, 15 are “hydrophones” is misplaced as she expressly admits that Genser “does not explicitly disclose a hydrophone.” See *id.* at p. 5. Moreover, the Examiner’s position that foam sensors 14, 15 can be “acoustic sensors” is also unsupported by substantial evidence. Specifically, Genser discloses that acoustic sensors may be substituted for the inclinometer 16 (not the foam sensors 14, 15) to measure the vibrations of the rotating container.

Notwithstanding that the foam sensors are not acoustic sensors, nowhere does Genser even remotely mention that the acoustic sensors generate “an output signal representative of an acoustic emission associated with the foam” as required in claims 1, 13 and 21. Instead, the acoustic sensors are solely used “to detect an acoustic vibration (sound wave) caused by the vibration [of the rotating container 2].” See *Col. 13, ll. 14-20*. Clearly, measuring the acoustic vibrations of the rotating container is not identical to “generating an output signal representative of an acoustic emission associated with the foam” or “detecting an acoustic emission of the foam” as required in the claimed inventions.

As the law provides, an “anticipation” rejection requires “strict identity” between the prior art invention and the one set forth in the claim. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (holding that an anticipating reference must describe all claimed aspects of the invention). The possibility, or even probability, that the claimed structure exists in the reference is inadequate to meet the “strict identity” requirement for a proper anticipation rejection. See *Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991) (holding that anticipation “may not be established by probabilities or possibilities”). As discussed above, Genser fails to disclose any passive sensor for generating an output signal representative of an

acoustic emission associated with the foam as required in claims 1 and 21. Accordingly, the anticipation rejections based upon Genser should be withdrawn.

For claim 13, the Examiner does not cite to any disclosure in the Genser reference of the step of “detecting an acoustic emission of the foam.” Rather, the Examiner simply states that “the claims are commensurate in scope with the above claims and are rejected for the same reason as set forth above.” This failure to apply the reference to the *method* steps of claim 13, which are distinguishable from the *apparatus* of claim 1, is reversible error.

For claim 21, the Examiner fails to follow the requirements of MPEP 2182 in resolving the disclosed structures corresponding to the “means plus function” elements and identifying corresponding structures in the cited reference. Rather, the Examiner rejects the claim, stating that “the claims are commensurate in scope with the above claims and are rejected for the same reason as set forth above.” This failure to follow well-established procedures of patent examination constitutes reversible error.

Applicant further notes reversible error in the rejections of many of the dependent claims. For example, claim 2 requires that the controller’s response is “a signal for activating a source of foam suppressant positioned adjacent the liquid.” In rejecting claim 2, the Examiner states that Genser suggests “a control signal to activate a source of foam suppressant (i.e. a drive means 6 which control [sic] the speed of the rotating container controls the evaporation process of the medium M where the foam MF develops).” See *Office Action dated 3-18-09*, p. 5. However, nowhere in the cited passage or anywhere in Genser does it even mention the use of a foam suppressant. Similarly, claims 9 and 14 require that the passive sensor is “a hydrophone positioned at or below the surface of the liquid in the column” and “placing a passive sensor in acoustic communication with the foam,” respectively. As discussed above, the Examiner admits that Genser does not explicitly disclose a hydrophone and Genser fails to disclose a sensor in acoustic communication with the foam.

In addition, claims 5-7 and 17-20 stand rejected under 35 U.S.C. § 103(a) as being obvious over Genser in view of U.S. Patent No. 6,484,568 to Griffith et al. (“Griffith”). The Examiner admits that “Genser does not explicitly suggest a system for testing a mineral admixture for making concrete.” See *Office Action dated 3-18-09*, p. 3. Nevertheless, the Examiner cites Griffith for teaching a foaming apparatus for making a concrete/cement with the foam and concludes that “[i]t would have been well known...to have readily recognize the advantages and desirability of combining the device with a system

for testing a mineral admixture for making concrete/cement as suggested by Griffith et al. to the apparatus of Genser.” *See id.*

Initially, a *prima facie* case of obviousness is lacking with respect to claims 5-7 because neither Genser nor Griffith teach each and every element of independent claim 1 (upon which claims 5-7 depend). As discussed above, Genser fails to disclose “a passive sensor for generating an output signal representative of an acoustic emission associated with the foam” as required in claim 1. In addition, the Examiner does not (and cannot) contend that Griffith teaches “a passive sensor for generating an output signal representative of an acoustic emission associated with the foam.”

Turning to independent claim 17, it requires a method of testing a mix used to form concrete, including the step of “detecting one or more acoustic emissions from the mix.” In rejecting claims 17-20, the Examiner merely contends that “the claims are commensurate in scope with claims 5-7 and are rejected for the same reasons.” *See id. at p. 4.* However, neither Griffith nor Genser disclose “detecting one or more acoustic emissions from the mix” to form concrete. As detailed above, Genser fails to disclose detecting any acoustic emission of the foam/mix. Further, the Examiner does not contend that Griffith teaches detecting one or more acoustic emissions from the mix as required in claim 17. Rather, the Examiner relies upon Griffith solely for disclosing a foaming apparatus for making a concrete/cement with the foam. Accordingly, the Examiner has not established a *prima facie* case of obviousness and claim 17 should be held allowable. In addition, dependent claims 18-20 are dependent upon independent claim 17. As a result, they are all also believed to be allowable.<sup>1</sup>

Finally, the Examiner also fails to provide the necessary support for combining the references to make an obviousness rejection. As observed by the U.S. Supreme Court, “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007) (*quoting In re Kahn*, 441 F.3d 977, 78 USPQ2d 1385 (2007)). The assertion that it would be “well known to...recognize the advantages and desirability of combining the device with a system for testing a mineral admixture for making concrete/cement as suggested by Griffith et al. to the apparatus of Genser” does not qualify as the requisite “articulated reasoning with some rational underpinning.” Rather, it is a “mere conclusory statement” based solely

<sup>1</sup> *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (holding that if an independent claim is nonobvious under Section 103, then any claim depending therefrom is nonobvious).

upon the Examiner's personal opinion without any supporting evidence. For this additional reason, a *prima facie* case of obviousness is lacking.

In summary, Applicant has identified factual and legal errors that is believed would lead to a reversal of all extant rejections on appeal. Upon careful review and consideration, it is believed the panel will agree that the Examiner has committed the foregoing reversible errors and find the inventions of all claims patentable over the cited prior art. In the event any fee is due for processing this document, please debit it from Deposit Account 11-0978.

Respectfully submitted,  
**KING & SCHICKLI, PLLC**

A handwritten signature in black ink, appearing to read "Andrew D. Dorisio", is written over the firm name.

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